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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/262,077 03/04/99 TAKANASHI H 1497/FPTOK16

EXAMINER

IM62/0103

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WASHINGTON DC 20006

LEE, S	
ART UNIT	PAPER NUMBER

1752

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DATE MAILED:

01/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/262,077

Applicant(s)

Takanashi et al.

Examiner

Sin J. Lee

Group Art Unit
1752



☒ Responsive to communication(s) filed on Oct 15, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 6-9 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Claims 1-5 are canceled by applicants.
2. In view of applicants' amendment filed on October 15, 1999, the previously made rejections on claims 1-5 under 35 U.S.C. 112, second paragraph are hereby withdrawn.
3. In view of applicants' amendment filed on October 15, 1999, the previously made rejections on claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Kita et al (4,239,850), Holman, III (4,634,657), and as being unpatentable over Legere (4,911,999) are hereby withdrawn. It is to be noted that the rejections over Legere are being withdrawn due to the fact that the prior art does not teach the presently claimed (by the amendment) thickness (0.45 to 0.8 mm) of the photosensitive layer.
4. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pine (4,361,640).

Pine teaches instant inventions of claims 6-9 except for explicitly disclosing the claimed range of 0.001 to 0.3 weight % for the amount of the compound having the formula (I) and the claimed range of 0.45 to 0.8 mm in thickness for the photosensitive layer. See particularly col.1, lines 20-23, lines 61-68, col.2, lines 1-23, lines 27-33, col.4, lines 20-27, lines 39-47, lines 58-62, lines 67-68, col.5, lines 1-15, col.6, lines 25-29.

With respect to claim 6, Pine teaches in col.4, lines 20-27 that a plasticizer can be present in his composition in amounts of 0 to 18% by weight, and he names mixed o,p-toluene sulfonamides as one of the six (not too many to choose from) useful plasticizers. Ortho or para toluene sulfonamides correspond to the applicants' component (E) having the formula (I)

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wherein -X represents $\text{-SO}_2\text{NHR}^2$. Therefore, it would have been obvious for one ordinarily skilled in the art to use the ortho or para toluene sulfonamides in the amount of 0 to 18% by weight since it is clearly taught in Pine. Also, in the case "where the [claimed] ranges overlap or lie inside ranges disclosed by the prior art," a *prima facie* case of obviousness would exist which may be overcome by a showing of unexpected results, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). As to the presently claimed thickness of the photosensitive layer, Pine teaches that layers within the range of 0.254 to 6.35 mm of thickness will be used for the majority of his printing plates (col.4, lines 39-47). Since this range overlaps with the presently claimed range of 0.45 to 0.8 mm, the prior art range would have made the presently claimed range *prima facie* obvious, In re Wertheim, supra.

With respect to claim 7, since Pine teaches the limitation of present claim 6 and since the mixed o,p-toluene sulfonamides have the boiling point of about 214°C, Pine teaches the present invention of claim 7.

5. Applicants' argument traversing the rejections on claims 1-5 over Pine (4,361,640) was carefully considered but was found unpersuasive. First of all, the range (0 to 18% by wt.) for the amount of o,p-toluene sulfonamides taught by Pine clearly encompasses the presently claimed range 0.001 to 0.3% by wt of the component (E). Secondly, it is the examiner's position that applicants did not show the criticality of the presently claimed range. Looking at the Table 1 on pg 31 of the specification, applicants show only one data point (comparative Example 4) which is out of the claimed range of 0.001 to 0.3% by wt. of the component (E). Besides, the comparative

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Example 4 uses stearyl alcohol which is different from the o,p-toluene sulfonamide taught by Pine. That is, applicants did not make the comparison to the closest prior art. Therefore, it is the Examiner's position to maintain the rejections of claims 1-5 over Pine.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is (703) 305-0504. The examiner can normally be reached on Monday-Friday from 8:30 am EST to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 for after final responses or (703) 305-7718 for all other responses.

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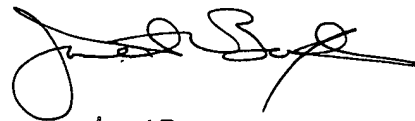
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

S. J. L.

S. Lee
January 3, 2000



Janet Baxter
Supervisory Patent Examiner
Technology Center 1700